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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/989,562   | 11/20/2001  | Shanku S. Niyogi     | 50037.67US01        | 1676             |
| 27488  | 7590        | 01/13/2005           | EXAMINER            |                  |
| MICROSOFT CORPORATION<br>C/O MERCHANT & GOULD, L.L.C.<br>P.O. BOX 2903<br>MINNEAPOLIS, MN 55402-0903 |             |                      | KENDALL, CHUCK O    |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 2122                |                  |

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/989,562

Applicant(s)

NIYOGI ET AL.

Examiner

Chuck Kendall

Art Unit

2122

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 03/15/04
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***DETAILED ACTION***

1. This action is in response to the application filed 11/20/01.
2. Claims 1 – 25 are pending.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 – 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 at line 3 recites, “identifying a type associated with the target device”. The claim does not state or provide any support for what is being included and/or excluded. Thus Claims 2 – 12 are also rejected for being dependent on a rejected base claim.

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 22 – 25 are rejected under 35 U.S.C. 101 because the claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program’s functionality to be **realized**. As per claim 22, mere claimed as a computer readable medium encoded with a data

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structure consists solely of an abstract idea and does not impart functionality either to the data as so structured, or to the computer and as such is a non functional descriptive material. See Warmerdam, 33 F. 3d at 1360, 31 USPQ2d at 1759. See also Schrader, 22 F. 3d at 295, 30 USPQ2d at 1459.

As per claim 23, claims also recites merely a computer readable medium comprises a file for storing data, thus is non functionally descriptive and as such is being rejected for same reason as discussed above.

As per claim 24, claims also recites merely a computer readable medium comprises a control hierarchy being stored, thus is non functionally descriptive and as such is being rejected for same reason as discussed above.

As per claim 25, merely claims a modulated signal encoded with a data structure and comprising of data fields components and thus is also non functionally descriptive and as such is being rejected for same reason as discussed above.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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6. Claims 1 –25 are rejected under 35 U.S.C. 102(e) as being anticipated by Schwartz et al. USPN 6,473,609 B1.

Regarding claim 1, Schwartz anticipates a computer-implemented method for providing content to a target device, the method comprising:

identifying a type associated with the target device (7: 55 – 65);

compiling an application based on a page file including information describing the content to be returned to the target device, the information including statements that provide choices for properties of the content to be returned, the choices being based on the type of target device (10: 3 – 18);

evaluating the choices to override existing values for the properties corresponding to the choices (15: 65 – 16:7);

and rendering the content based on the evaluated choices within the compiled application (16:5 – 7, see key in to select).

Regarding claim 2, the computer-implemented method of claim 1, wherein the type is included within an instruction to transmit the content to the target device (15: 15 – 30).

Regarding claim 3, the computer-implemented method of claim 2, wherein the instruction comprises a request generated by the target device (3: 10 – 25, also see 38 – 50).

Regarding claim 4, the computer-implemented method of claim 3, wherein the request comprises an HTTP request for the page file (11: 15 – 25).

Regarding claim 5, the computer-implemented method of claim 3, wherein the instruction further includes an identification of the page file (14: 55 – 67).

Regarding claim 6, the computer-implemented method of claim 1, wherein the information describing the content includes tags within the page file that identify at least one server object that is programmed to create the content (11: 53 – 57, see tag based).

Regarding claim 7, the computer-implemented method of claim 1, wherein the statements that provide the choices include a declarative statement identifying at least one choice for at least one property of a server object corresponding to the declarative statement (12:3 – 14).

Regarding claim 8, the computer-implemented method of claim 7, wherein the at least one choice applies if a pre-determined condition is satisfied (9: 65 – 67, see rules).

Regarding claim 9, the computer-implemented method of claim 1, wherein compiling the application further comprises generating code that describes a control hierarchy of server objects (3: 40 – 50, see network server) that are programmed to create the content (see message processor).

Regarding claim 10, the computer-implemented method of claim 9, wherein evaluating the choices comprises instantiating the control hierarchy based on the generated code (3: 38 – 50, see control engine).

Regarding claim 11, the computer-implemented method of claim 9, wherein a server object includes a property and the control hierarchy further includes at least one choice for that property, the choice including a filter against which the type of target device is evaluated to determine whether to apply that choice to the property (19: 1 – 15, see SDD corresponding to mobile devices characteristics also see control engine).

Regarding claim 12, the computer-implemented method of claim 1, wherein evaluating the choices includes comparing the type of target device against a filter to determine whether to apply that choice to the property (19: 1 – 15).

Regarding claim 13, the computer medium version of claim 1, see rationale as previously discussed above.

Regarding claim 14, the computer medium version of claim 3, see rationale as previously discussed above.

Regarding claim 15, the computer medium version of claim 4, see rationale as previously discussed above.

Regarding claim 16, the computer medium version of claim 5, see rationale as previously discussed above.

Regarding claim 17, the computer medium version of claim 6, see rationale as previously discussed above.

Regarding claim 18, the computer medium version of claim 7, see rationale as previously discussed above.

Regarding claim 19, the computer medium version of claim 8, see rationale as previously discussed above.

Regarding claim 20, the computer medium version of claim 9, see rationale as previously discussed above.

Regarding claim 21, the computer medium version of claim 10, see rationale as previously discussed above.

Regarding claim 22, which claims similarly to claim 1, see rationale as previously discussed above.

Regarding claim 23, the computer-readable medium of claim 22, wherein the data structure comprises a page file stored on an application server (3: 62 – 65).

Regarding claim 24, which claims similarly to claim 9, see rationale as previously discussed above.

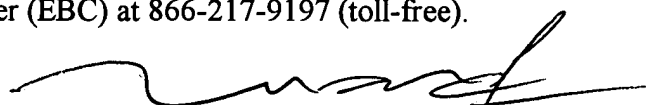
Regarding claim 25, the data signal version of claim 1, see rationale as previously discussed above.

#### *Conclusion*

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chuck Kendall whose telephone number is 571-2723698. The examiner can normally be reached on 10:00 am - 6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Dam can be reached on 571-2723695. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**TUAN DAM**  
**SUPERVISORY PATENT EXAMINER**